

### **REMARKS**

1. In response to the final Office Action mailed June 4, 2004, Applicant respectfully requests reconsideration. Claims 21-39 were last presented for examination. All the claims were rejected in the outstanding Office Action. By the foregoing amendments, claims 23, 32 and 35 have been amended. No claims have been added or canceled. Thus, upon entry of this paper, claims 21-39 will remain pending in this application. Of these nineteen (19) claims, two (2) claims (claims 21 and 32) are independent. Based on the above Amendments and following Remarks, Applicant respectfully requests that the outstanding objections and rejections be reconsidered, and that they be withdrawn.

#### ***Art of Record***

2. Applicant acknowledges receipt of form PTO-892 (part of PTO Prosecution paper No. 4) listing additional references identified by the Examiner.

#### ***Claim Objections***

3. The Examiner has objected to claims 23, 32 and 35 for including informalities. Applicant has amended the claim in accordance with the Examiner's suggestion. Accordingly, Applicant request that these objections be withdrawn.

#### ***Claim Rejections Under 35 U.S.C. §103***

4. The Examiner has rejected claims 21, 22, 24, 26, 28-34, 36 and 38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,035,119 to Massena, *et al.*, (hereinafter, Massena) in view of U.S. Patent No. 6,598,035 to Branson, *et al.* (hereinafter, Branson). Also, the Examiner has rejected claims 23 and 35 35 U.S.C. §103(a) as being unpatentable over Massena in view of Branson and further in view of U.S. Patent No. 6,654,754 to Knauff, *et al.* (hereinafter, "Knauff"), while claims 25, 27, 37 and 39 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Massena in view of Branson and further in view of U.S. Patent No. 5,708,825 to Sotomayer (hereinafter, "Sotomayer").

5. Specifically, the Examiner asserts that Massena substantially teaches Applicant's invention as recited in independent claims 21 and 32. The Examiner concedes, however, that Massena does not teach the limitation of "wherein each code section utilizes one of the

following object-oriented classes each of which models a type of markup language element: an in-line class that models a first type of markup language element in which other markup language elements cannot be nested, and which comprises an opening tag, an argument and no closing tag; and a container class that models a second type of markup language element in which other markup language elements can be nested, and which comprises an opening tag, a closing tag and an argument disposed between the opening and closing tags.” The Examiner turns to Branson for such teachings, asserting that Branson teaches that various restrictive rules and conditions can be implemented in an object-oriented program.

6. Based on the above interpretations of Massena and Branson, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Branson into Massena and that such a modification would result in Applicant’s invention as recited in independent claims 21 and 32: “Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to have modified Massena’s invention of producing markup language documents by including well-known defined features of HTML such as objects, classes, derived classes and tags. And furthermore to include permissive and restrictive rules and conditions, as supplied by Branson when creating and designing classes and relationships because these are all known abilities in the markup language as originally defined by W3 Consortium. Applicant respectfully traverses this rejection.” (*See*, Office Action, pg. 7.)

7. Applicant respectfully traverses this rejection for at least the following reasons. First, the modification of Massena is improper as there is no teaching or suggestion in Massena or any other art of record that Massena be modified, much less that it be modified in the manner proposed. Second, even if Massena were to be combined with Branson as proposed in the Office Action, the resulting device would not contain all the elements of Applicant’s claimed invention since neither Massena nor Branson teach or suggest features of Applicant’s claimed invention.

8. The Examiner has not provided proper support for the assertion that one of ordinary skill, without having the benefit of Applicant’s novel teachings before them, would have been motivated to make the novel combination of elements required to create Applicant’s invention as recited in independent claims 21 and 32. Neither Massena, Branson, nor the other art of record contain any teaching or suggestion whatsoever to combine the teachings of Massena and Branson in any way, much less in the manner proposed by the Examiner.

9. Massena is directed to automatically generating text and computer executable code to a web page hosted on a server. A design-time control, which is run at design time of the web page, writes HTML information to a previously created web page. The HTML information may include text and other text based components. Through the use of OLE, the control incorporates author-friendly capabilities including in place editing, property sheets, and persistence. (*See*, Massena, Abstract; col. 2, lns. 44-67.) The design-time controls are similar to embedded wizards that can continuously be edited to modify the text they generate for a web page. A developer inserts design-time controls into a file to provide a desired functionality to the web page. (*See*, Massena, col. 3, lns. 11-16; 31-36; and col. 4, lns 53-57.) Massena teaches that such controls can be implemented in C++ code in a C++ development environment. (*See*, Massena, col. 2, lns. 65-67.)

10. Branson is directed to a framework for use with object-oriented programming systems to provide an expert system shell that executes a rule set developed by the framework user. (*See*, Branson, Abstract.) The framework included a condition manager object that keeps track of what conditions are true at any time, and a rules compiler that processes the rules so they can be used by the condition manager. The conditions are a set of object classes that are organized into an inheritance hierarchy for use by the condition manager. The set of rules and conditions comprise extensible object oriented classes that are customized by the expert system developer. (*See*, Branson, col. 2, lns. 14-24, 58-63.)

11. The rejection sets forth that the reason for motivating one of ordinary skill in the art to modify Massena with the teachings of Branson is that they are “well-known abilities in the markup language as originally defined by the W3 Consortium.” (*See*, Office Action, page 7.) Applicant respectfully asserts that this is an insufficient and, hence, an improper basis for rejecting claims under Section 103. The fact that object-oriented design language provides designers with a variety of capabilities is insufficient support for the assertion that one of ordinary skill would be motivated to select certain ones of those features and implement them in the manner recited in Applicant’s claims. In other words, the Examiner’s stated basis for rejecting the claims constitutes an assertion that since there are general capabilities provided by the object-oriented development environment, that one of ordinary skill could have implemented Applicant’s claimed invention. However, the fact that one of ordinary skill could have implemented Applicant’s claimed invention does not constitute a clear teaching or motivation to actually make Applicant’s claimed invention.

12. Thus, the only conclusion that can be drawn, based on the record of this Application, is that the suggestion forming the basis for the Examiner's otherwise factually unsupported conclusion must of come from Applicant's own novel disclosure; that is, they are based impermissible hindsight. It is too well settled for citation that Applicant's own novel disclosure cannot be used to supply the teachings or suggestion that is missing from the known art. Accordingly, Applicant respectfully asserts that not legitimate rationale for modifying Massena, let alone that it be modified or suggested by the Examiner, has been set forth in the Office Action. For these reasons alone, Applicant respectfully requests that the rejection under 35 U.S.C. 103 of independent claims 21 and 32 be reconsidered and that they be withdrawn.

13. Further, even if Massena were to be combined with Branson as suggested in the Office Action, the resulting system would still not result in, neither would it have the advantages of, the present invention without substantial modifications being made to the resulting system. Specifically, in contrast to Massena, Branson or the combination thereof, independent claim 21 comprises, *inter alia*, "wherein each code section utilizes one of the following object-oriented classes each of which models a type of markup language element: an in-line class that models a first type of markup language element in which other markup language elements cannot be nested, and which comprises an opening tag, an argument and no closing tag; and a container class that models a second type of markup language element in which other markup language elements can be nested, and which comprises an opening tag, a closing tag and an argument disposed between the opening and closing tags." (*See*, Applicant's claim 1, above.)

14. This combination of recitations is nowhere taught or suggested by Massena, Branson or the other art of record. Branson, as admitted by the Examiner, does not expressly teach such features of Applicant's claimed invention. Thus, the combination of Massena and Branson, even if it were suggested by other than hindsight, would not meet the teachings of Applicant's invention as recited in independent claims 21 and 32. For these reasons alone, Applicant respectfully requests that the rejection under 35 U.S.C. 103 of independent claims 21 and 32 be reconsidered and that they be withdrawn.

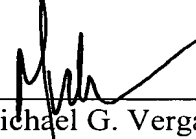
15. The dependent claims depend directly or indirectly from independent claim 1, are allowable for at least the same reasons as independent claim 1. Further, Applicants submit

that each of these dependent claims are also patentable in and of themselves because they each recite features that are not anticipated nor rendered obvious by the art of record.

***Conclusion***

16. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael G. Verga", is written over a horizontal line.

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